

B. Rejection on the Merits.

1. Rejection Under the Judicially Created Doctrine of Obviousness-Type Double Patenting.

Claims 21-37 were rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 5,772,560 issued to Watterson. With this response, applicant submits a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) that shows that U.S. Patent No. 5,772,560 is commonly owned by the Assignee of the pending application. In view of the foregoing, applicant respectfully submits that the double patenting rejection is now moot with respect to all pending claims and, therefore, should be withdrawn.

2. Rejection of Claims 21-34 under 35 U.S.C. § 103(a).

Claims 21-34 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 4,664,646 issued to Rorabaugh (hereinafter "*Rorabaugh*") in view of U.S. Patent No. 4,340,766, issued to Teague et al (hereinafter "*Teague*"). Applicant respectfully traverses.

In general terms, *Rorabaugh* was cited for disclosing a support structure and a tread base rotatably attached to the support structure, such that the tread base is selectively movable between an operating position and a storage position (col. 4, lines 50-57). The Examiner acknowledges that *Rorabaugh* does not disclose a gas spring connected between the support structure and the tread base. The Examiner, however, argues that it would have been obvious to combine *Rorabaugh* with *Teague*, which includes a gas spring used to assist the lifting of a bed into a vertical position. Applicant respectfully traverses.

To set forth a *prima facie* case of obviousness the following elements must be shown, according to M.P.E.P. § 2143:

- (1) suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify the reference or combine reference teachings;
- (2) ...
- (3) the combined references must teach or suggest all the claim limitations of the applicant's claims.

Additionally, the fact that the references can be combined is not sufficient to establish *prima facie* obviousness unless the prior art, in addition, suggests the desirability of the combination. M.P.E.P. § 2143.01.

Rorabaugh is specifically directed to a treadmill motor drive that is sufficiently narrow to fit "within the width profile of the treadmill idler rollers" (col. 2, line 48 - col.3, line 23). Formation of the treadmill motor reduces bearing stresses on the drive roller while a speed reducer effectively multiplies the rotational inertia of a motor-shaft mounted flywheel (Abstract). Located adjacent to the treadmill motor drive is a first hinge attached to the treadmill base, while a second hinge attaches to the cabinet (Figure 2, col. 3, lines 44-52). This is the only mention of the structure used to fold the treadmill.

Counsel for applicant has earnestly studied the *Rorabaugh* patent, but has been unable to find any mention whatsoever, much less any discussion, of the need for any type of means or mechanism to assist a user in lifting the treadbase from the operating position to the storage position. This finding is consistent with the objects of the invention set forth in the *Rorabaugh* patent, which make no reference to any lift assist means or the need for or desirability of such a feature (col. 2, lines 33-44):

Therefore, it is an object of the present invention to provide a treadmill motor drive having a small, relatively lightweight drive motor.

It is a further object of the present invention to provide a treadmill motor drive having substantial rotational inertia without the use of heavy, massive parts.

Another object of the present invention is to provide a treadmill motor drive which fits within a narrow profile consistent with a lightweight, folding treadmill.

A still further object of the present invention is to provide a treadmill motor drive with reduced stress upon the bearings supporting the treadmill drive roller.

Accordingly, the *Rorabaugh* patent provides absolutely no suggestion or motivation for combining the references in the manner suggested by the Examiner.

Teague discloses a counterbalancing mechanism for a panel bed (*i.e.*, a "Murphy bed") that uses a gas spring as part of the counterbalancing mechanism (Figures 2-4). Again, counsel for applicant has earnestly studied the *Teague* patent, but has found absolutely no reference to any teaching, suggestion or motivation directed, either explicitly or by implication, to the need or desirability of applying the counterbalance mechanism disclosed therein to any other application or field of art. Furthermore, applicant respectfully submits that one skilled in the exercise equipment art would not logically look to prior art dealing with beds to obtain features or structures to be used with exercise equipment. Therefore, Applicant submits that it is improper for the Examiner, with the benefit of hindsight and armed with applicant's invention as a road map, to indiscriminately pick and choose from among discrete and unrelated parts of the prior art (especially nonanalogous prior art) as a mosaic to recreate a facsimile of applicant's invention. *Compare Akzo N.V. v. United States*, 808 F.2d 1471 (Fed. Cir. 1986).

For the forgoing reasons, applicant respectfully submits that claims 21-34 are not obvious over *Rorabaugh* in view of *Teague*.

3. Rejection of Claims 35-37 under 35 U.S.C. § 103(a).

Claim 35 was rejected under 35 U.S.C. § 103 as being unpatentable over *Rorabaugh* in view of *Teague* as applied to U.S. Patent No. 4,026,545 issued to Schönenberger (hereinafter "*Schönenberger*"). Claims 36-37 were rejected under 35 U.S.C. § 103 as being unpatentable over